

Serial No. 10/054,257

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Pre-Appeal Brief

UTILITY PATENT

SEP 14 2007

B&D No. TN -2239

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Frederick R. BEAN et al.**

Serial No.: 10/054,257

Examiner: **P. Nguyen**

Filed: **January 22, 2002**

Group Art Unit: 3724

For: **MITER SAW**

Assistant Commissioner for Patents
Washington, DC 20231

PRE-APPEAL BRIEF REQUEST FOR REVIEW

I, Adan Ayala, PTO Reg. No. 38,373, hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office, Fax No. (571) 273-8300 on Sep 14, 2007


Adan Ayala

Dear Sir:

This is in response to the final Office Action of June 26, 2007. A Notice of Appeal has been filed herewith.

Currently pending in the application are Claims 1-7, 9-10 and 13-16.

The Examiner rejected Claim 13 under 35 USC § 103(a) as being unpatentable over US Patent No. 5,778,747 ("Chen") in view of US Patent No. 5,957,021 ("Meredith"). Applicants request that this rejection be overturned.

Claim 13 calls for a chop saw comprising a base assembly, and a saw assembly pivotably attached to the base assembly, the saw assembly comprising an upper blade guard, a plate

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rotatably attached to the upper blade guard, a lower blade guard rotatably attached to the plate, and a screw engaging the upper blade guard for fixing the plate, wherein at least one of the upper blade guard and plate have a first tab disposed near the screw and extending outwardly and substantially perpendicularly to the at least one of the upper blade guard and plate, the first tab extending from the at least one of the upper blade guard and plate a first distance, the screw being required to be moved a second distance longer than the first distance in order to pivot the plate so that the lower blade guard contacts the screw upon rotation of the lower blade guard, wherein the lower blade guard contacts the screw upon rotation of the lower blade guard after the screw has been moved the second distance.

As admitted by the Examiner, Chen does not disclose the claimed first tab. The Examiner relies on Meredith to provide such first tab. However, Claim 13 requires more than just a first tab.

Claim 13 also requires that the lower blade guard can contact the screw upon rotation of the lower blade guard once the screw is moved to clear the first tab. As shown in FIG. 11 of Meredith, lower blade guard 42 cannot contact screw 69 regardless of the screw's position. Chen is necessarily silent on such feature as it does not have the first tab.

By contradistinction, Claim 13 requires "that the lower blade guard contacts the screw upon rotation of the lower blade guard, wherein the lower blade guard contacts the screw upon rotation of the lower blade guard after the screw has been moved the second distance." Being that such result is not taught or suggested by Chen and/or Meredith, the Chen/Meredith

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combination render unpatentable Claim 13. Therefore, the rejection based on Chen/Meredith should be withdrawn.

The Examiner argues that "it is well known the [sic] art that the plate and the lower guard have a small tolerance." This is an improper basis for a rejection in a final Office Action for several reasons.

First, while official notice without documentary evidence to support an examiner's conclusion is permissible in some circumstances, "these circumstances should be rare when an application is under final rejection." MPEP § 2144.03(A). In the present case, the Examiner has raised this "well known" prior art for the first time in the final Office Action.

Second, none of the prior cited by the Examiner shows or discloses a small tolerance between the plate and the lower guard. In fact, many references cited by the Examiner show substantial separation between the plate and the lower guard, i.e., the opposite of the Examiner's allegations. See, e.g., Meredith, US Patent Nos. 6,431,042, 6,476,206, etc.

Accordingly, Applicants request that, if examination of the present application were to be reopened, the Examiner be ordered to provide documentary evidence showing the existence of the "small tolerance" existing between the plate and the lower guard. See MPEP § 2144.03 ("If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained.") (citing 37 CFR § 1.104(c)(2); *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed.

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Cir. 2001) ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test)).

Nonetheless, Applicants request that the present claims be allowed. The presently-appealed rejection was previously considered by the pre-appeal panel in a previous pre-appeal review. The Examiner has used the same prior art references and the claims have not been amended since the panel's decision on November 30, 2006. Accordingly, Applicants submit that the Examiner be reversed as before and that the claims be allowed.

The Commissioner is authorized to charge payment of any fees due in processing this response, or credit any overpayment to Deposit Account No. 02-2548.

Respectfully submitted,


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